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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,135	02/22/2000	Dietrich Arbenz	GR 97 P 2193	4443

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EXAMINER

GESESSE, TILAHUN

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/523,135

Applicant(s)

ARBENZ, DIETRICH

Examiner

Tilahun B Gesesse

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 15 and 18 is/are rejected.
- 7) ☐ Claim(s) 14-, 16-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This is in response applicant's amendment and response filed March 8, 2004, in which claims 1-11 and 13-18 are pending.

#### ***Claim Objections***

2. Claim 18 is objected to because of the following informalities: phonic information about at least part of the at least one. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

- The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
4. Claims 1-11, 13, 15 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Borland (6,320,943).

As to claim 1, Borland discloses a method of determining a communication partner's technical address for a user (column 4, lines 16-48 and figure ), comprises: providing a directory that includes at least one technical address (telephone number) and at least one identification to reach one of a plurality of possible communication partners for a user (name or home address)(column 5, lines 29-42 and figure 2), based on an input from the user (keys in a keypad or special functions) and previous communication behavior of the user, automatically, obtaining at least one possible communication partner from the directory and suggesting the possible communication partner to the user (column 4, lines 16-48, column 5, lines 29-43 and figures 1 and 2).

As to claim 2, Borland discloses providing the directory by using at least one directory being sorted based on a call probability , the at least one directory being selected from the group consisting a user specific directory (figure 2)

As to claim 3, Schlachman discloses providing the directory as a personal directory for the user (column 5, lines 29-42 and figure 2).

As to claim 4, Borland discloses providing a directory includes obtaining the at least one technical address for each one of the plurality of possible communication partners by recording technical addresses of the user's previous communicating partners (column 4, line 50-column 5, line 6).

As to claim 5, 11,13, Borland discloses a method of determining a communication partner's technical address for a user (column 4, line 50-column 5, line 6 and figure 2), comprises: providing a directory that includes at least one technical address (telephone number) and at least one identification to reach one of a plurality of possible

communication partners for a user (name or home address)(column 4 line 50-column 5 line 6), based on an input from the user (keys in a keypad or special functions) and previous communication behavior of the user, automatically, obtaining at least one possible communication partner form the directory and suggesting the possible communication partner to the user (column 4, line 16-42 and figure 1)

As to claim 6, Borland discloses requesting from the user, the at least one identifier for at least one of the plurality of possible communication partners (column 4, line 16-42 and figure 1)

As to claims 7-8, Borland discloses input from the user includes information about at least part of the at least one technical address of a desired communication partner (column 4, line 16-42 and figure 1).

As to claims 9-10, Borland discloses if the input from the user is ambiguous, perfumed based on the user's previous communication behavior (column 4 line 50-column 5 line 6 and figure 2).

As to claim 15, Borland discloses from director based on call frequency between the user and others (priority is based on frequency of contact , see figure 2).

As to claim 18, Borland discloses the input from the user includes phonetic information about at least one identifier of a desired communication partner (column 4 lines 16-42).

***Allowable Subject Matter***

5. Claims 14,16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of

the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not disclose the predetermined selection strategy is based on a points key of combined criteria the criteria are selected from the group consisting of call frequency, time of least call and identifier match.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-11 and 13 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun B Gesesse whose telephone number is 703-308-5873. The examiner can normally be reached on flex.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TBG

Art unit 2684

May 15, 2004

  
TILAHUN GESESSE  
PATENT EXAMINER